REMARKS

This application has been reviewed in light of the Office Action dated June 19, 2007. Claims 49, 50, 52-61 and 63-72 are presented for examination, of which Claims 49, 60, 71 and 72 are in independent form. Claims 49, 52, 60, 63, 71 and 72 have been amended to define Applicant's invention more clearly. Claims 51 and 62 have been canceled without prejudice or disclaimer of subject matter. Favorable reconsideration is respectfully requested.

In the outstanding Office Action, Claims 49-72 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,073,142 (*Geiger et al.*) in view of U.S. Patent No. 6,654,787 (*Aronson et al.*).

In the aspects of the present invention to which the present independent claims are directed, an E-mail to be sent to a communication apparatus is first stored in a mail box provided on an E-mail server connected to the communication apparatus through a network. On such a premise, before the E-mail is received from the E-mail server, a discrimination is made, based on size information of the E-mail from the E-mail server, whether or not to receive the E-mail. If it is discriminated to receive the E-mail, the apparatus sends a command to the E-mail server and then the E-mail is actually received by the communication apparatus. On the other hand, if it is discriminated not to receive the E-mail, then the E-mail is not received from the E-mail server by the communication apparatus, and a further discrimination is made as to whether or not to receive another E-mail that has been stored in the mail box and has been discriminated not to be received.

Claim 49 is directed to a communication apparatus which is connected to an E-mail server via a network, the apparatus comprising a receiving unit, a first obtaining unit and a discrimination unit. The receiving unit receives an E-mail from the E-mail server which is to

be sent to the communication apparatus, stored in a mail box provided on the E-mail server, and the first obtaining unit obtains size information from the E-mail server, the size information indicating a size of the E-mail stored in the mail box. The discriminating unit makes a discrimination as to whether or not to receive the E-mail stored in the mail box, and does this before the receiving unit receives the E-mail from the E-mail server. The discrimination is made based on the size information obtained by the first obtaining unit. In a case where the discrimination is that the E-mail should be received, the receiving unit sends a command to the E-mail server, and the receiving unit receives the E-mail that the discrimination unit has discriminated to receive. In a case where the discrimination is that the E-mail should not be received, the receiving unit does not receive the E-mail that the discrimination unit has discriminated not to receive. The discriminating unit further makes a discrimination as to whether or not to receive a different E-mail that is stored in the mail box.

Among other notable features of Claim 49 are the first obtaining unit and the discriminating unit. By virtue of the these features, as set out in Claim 49, before the E-mail is actually received from the E-mail server, a discrimination, based upon the size of the E-mail, can take place for the E-mail that is located in the mail box of the E-mail server. Thus, it is possible to ensure that an E-mail that meets the criterion for being received, is received, and is not left in the mail box.

For example, in a case where a large E-mail (that is, one exceeding a specified size) cannot be received on the communication apparatus because the communication apparatus does not have sufficient available storage area, the communication apparatus can discriminate not to receive the E-mail without actually receiving the E-mail from the E-mail server. On the other hand, in a case where the size of the E-mail stored in the mail box of the E-mail server is less

than the available storage area of the communication apparatus, the E-mail can be received from the E-mail server by sending a command from the communication apparatus to the E-mail server.

Applicant notes that the Office Action concedes that "*Geiger* does not explicitly teach a discriminating unit, adapted to discriminate whether or not to receive the E-mail stored in the mail box before said receiving unit receives the E-mail from the E-mail server, based on the attribute information." Therefore, applying the same logic, Applicant also submits that nothing in *Geiger* is believed to teach or suggest the discriminating unit of amended Claim 49.

Geiger apparently uses a business rule provided by an organization such as a company or the like, and applies that rule to an E-mail system. To support the rejection the Office Action suggests that the "RULE ENFORCING POST OFFICE 102" in Fig. 1 corresponds to the "communication apparatus" of the present application. However, as used in Claim 49, the "communication apparatus" is the intended destination of the E-mail (i.e., the location where E-mail is sent after the discrimination), not the E-mail server. Applicant submits that the Office Action does not accurately differentiate the communication apparatus from the E-mail server, as those are used in Claim 49. Applicant further submits that this is not equivalent to the "RULE ENFORCING POST OFFICE 102" of *Geiger*.

In addition, *Geiger* does not disclose a first obtaining unit of a communication apparatus that can obtain size information from said E-mail server, the size information indicating a size of the E-mail stored in the mail box, much less a discrimination unit that can discriminate whether or not to receive the E-mail stored in the mail box before said receiving unit receives the E-mail from the E-mail server, based on the size information obtained by the first obtaining unit, as set forth in Claim 49.

Applicant submits that the deficiencies of *Geiger,* with respect to the rejection of Claim 49, are not cured by the teachings of *Aronson.*

Aronson relates to an application programming interface that, in one embodiment, executes on an email server which can apply filtering rules to received E-mails and sort them into "Spam" and "non-Spam" E-mails. *Aronson* is not believed to disclose, teach, or suggest the discrimination unit or the first obtaining unit of Claim 49. *Aronson*, as understood by Applicant, merely discusses how the server 130 detects transmission source information and words within text, thereby filtering a received E-mail, which in turn prevents the delivery of unwanted "Spam" E-mail further on to client 110. This does not disclose or suggest a discrimination made based upon the size information of the E-mail from the E-mail server indicating a size of the E-mail stored in the mail box as set forth in Claim 49. Therefore, any such filtering in *Aronson*, cannot be deemed to teach or suggest the discrimination unit of Claim 49.

At most, The "RULE ENFORCING POST OFFICE 102" in *Geiger* and the "server 130" of *Aronson* perform E-mail filtering based on information of an E-mail only <u>after</u> receiving the E-mail from an E-mail server. Accordingly, *Geiger* and *Aronson* are not believed to teach or suggest that the apparatus corresponding to "communication apparatus" of Claim 49 discriminates whether or not to receive the E-mail located in the E-mail server mail box <u>before</u> receiving the E-mail.

In particular, in a case of discriminating whether or not to receive the E-mail based on the size information of the E-mail, it is conceivable that the result of the discrimination as to whether or not to receive an E-mail can be different for different communication apparatuses at the destination in communication with the E-mail server. This

could happen, for example, if some communication apparatuses did have sufficient available storage to receive the E-mail and other communication apparatus' did not have sufficient available storage to receive the E-mail. Nevertheless, by virtue of the features of the apparatus of Claim 49, even in such cases, the discrimination by the communication apparatus still takes place based on size information indicating a size of the E-mail and the E-mail is either received at the communication apparatus or is not received.

Applicant submits that nothing in *Geiger* or *Aronson*, whether considered individually or in any permissible combination, if any, would teach or suggest the first obtaining unit and the discriminating unit of the apparatus of Claim 49. Accordingly, it is believed that Claim 49 is allowable over *Geiger* and *Aronson*.

Independent Claims 60, 71 and 72 are method, program, and computer medium claims, respectively, corresponding to apparatus Claim 49, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 49.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or the other of independent Claims 49 and 60, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Leonard P Diana/

Leonard P. Diana
Attorney for Applicant
Registration No.: 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

FCHS_WS 1464196v1